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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/389,321      | 09/03/1999  | TOSHIRO HIRAMOTO     | 026350-028          | 5290             |

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EXAMINER

DICKEY, THOMAS L

| ART UNIT | PAPER NUMBER |
|----------|--------------|
| 2826     |              |

DATE MAILED: 05/01/2002

#15

Please find below and/or attached an Office communication concerning this application or proceeding.

|                        |                             |                  |
|------------------------|-----------------------------|------------------|
| <b>Advisory Action</b> | Application No.             | Applicant(s)     |
|                        | 09/389,321                  | HIRAMOTO ET AL.  |
|                        | Examiner<br>Thomas L Dickey | Art Unit<br>2826 |

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 19 April 2002 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a)  The period for reply expires 3 months from the mailing date of the final rejection.
- b)  The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.  
ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1.  A Notice of Appeal was filed on 19 April 2002. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2.  The proposed amendment(s) will not be entered because:
  - (a)  they raise new issues that would require further consideration and/or search (see NOTE below);
  - (b)  they raise the issue of new matter (see Note below);
  - (c)  they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
  - (d)  they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_

3.  Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
4.  Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5.  The a) affidavit, b) exhibit, or c) request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6.  The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7.  For purposes of Appeal, the proposed amendment(s) a) will not be entered or b) will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_.

Claim(s) objected to: \_\_\_\_\_.

Claim(s) rejected: 1-12.

Claim(s) withdrawn from consideration: \_\_\_\_\_.

8.  The proposed drawing correction filed on \_\_\_\_\_ is a) approved or b) disapproved by the Examiner.
9.  Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.
10.  Other: \_\_\_\_\_

  
NATHAN J. FLYNN  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2800  
Advisory Action

Continuation of 5. does NOT place the application in condition for allowance because: Applicants first supply four non-U.S. patent citations to help define the claim terms EIB, EIB-MOS, and VTMOS. These articles are useful background but otherwise moot. They cannot be incorporated by reference (See MPEP 608.01(p)). They are not listed on a form 1449 along with the showing required for filing an IDS at this time, so they will not appear "of record." See 37 CFR 1.97, 1.98 and MPEP § 609. The mootness of these articles is completed by the fact that the examiner has defined claim terms EIB, EIB-MOS, and VTMOS with reference to applicants' specification, which is "of record," and applicants do not take exception to the definitions the examiner has made. Applicants next argue that Burr does not teach "applying" a bias to the n<sup>+</sup> type substrate, but rather "connecting" a bias to one or both of a n<sup>+</sup> or p<sup>+</sup> backgate. However, the n<sup>+</sup> backgate is in constant electrical contact (i.e. a current will flow between these elements until, in steady state, both elements have the same bias applied) with the substrate, it is clear that Burr teaches applying a bias to the substrate. Finally applicants argue that although Burr teaches each and every physical element or step of the claims, Burr does not disclose the claimed function, namely, inducing charges of second polarity over the composition surface of the body region. This is old ground. It is covered in Paper #11 on page 4 lines 17-20. Applicants have not addressed this material. Further, when the art discloses all elements of a claimed device or method, except the claimed function, a *prima facie* case is established which the applicant must refute by showing that the claimed function does not follow naturally from the rest of the claim, which is old. Note that functional language in a device claim is directed to the device *per se*, no matter which of the device's functions is referred to in the claim. See *In re Ludtke and Sloan*, 169 USPQ 563 at 567, and *In re Swinehart* 169 USPQ 226, both of which make it clear that it is the patentability of the device *per se* which must be determined in a "functional language" claim and not the patentability of the function, and that an old or obvious device alleged to perform a new function is not patentable as a device, whether claimed in "functional language" claims or not. Note that applicant has the burden of proof in such cases, as the above caselaw makes clear..